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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,946

04/13/2004

Curtis E. Jutzi

P18836

5446

7590  
Garrett IP, LLC  
c/o CPA Global  
P.O. Box 52050  
Minneapolis, MN 55402

03/25/2010

EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2424

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,946	<b>Applicant(s)</b> JUTZI, CURTIS E.	
	<b>Examiner</b> Justin E. Shepard	<b>Art Unit</b> 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-9 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-9 and 13-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments filed 1/5/10 have been fully considered but they are not persuasive.

Page 8, 101 section:

See modified 101 rejection below.

Pages 9 and 10:

The applicant argues that while the references teach portions of the claim limitations, the references do not teach where the determining is performed by the remote control as is claimed. The examiner argues that Ellis (figure 5) teaches a system where the set top box and the remote is a single device (parts 500 and 200). When the set top box receives a tuning command, it determines whether the tuning command should be performed by the set top box or the television (paragraph 61, lines 18-21; paragraph 60, lines 14-20; i.e. when the VCR is recording a program being tuned by the STB and the STB receives an additional request, the request is passed onto the television tuner using the STB's IR transmitter). Therefore the determining is done by the remote control, which happens to be the same physical device as the STB. The applicant is invited to amend the claims to better teach that remote device is separate from the STB as is shown in figure 1 (parts 114 and 102) of the applicant's specification.

Page 10, last paragraph continuing onto page 11:

The applicant argues that Ellis does not teach automatically changing the television, with the remote control, to the identified cable channel to satisfy expectations of a user when the tuner is not available for the television. Ellis teaches (paragraph 61, lines 18-21) that if the STB tuner is busy outputting a signal to the VCR for recording, tuning requests will be passed onto the television without user intervention. This section is seen as meeting the claimed limitation.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The preamble has been amended to include a "computer-readable medium comprising a device," which is not found in the applicant's specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: It is unclear how a computer readable medium would comprise a device, as the medium is defined as a disk, ROM, etc. in paragraph 16 of the applicant's specification.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer readable medium comprising a device does not fit into a statutory category as it has been shown above that it is not clear how a computer readable medium would comprise a device. The applicant should either remove the mentions of waves, signals, etc from paragraphs 16 and 17 in the published specification, or amend the preamble to state a "non-transitory medium" instead of a device.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Arad in view of Silver.

Referring to claim 4, Ellis teaches a method comprising:

determining, by a remote control, a channel to which a television was tuned (paragraph 60, lines 14-20);

determining, by the remote control, whether the channel tuned to was a channel via a media center set-top box (paragraph 59, lines 18-23; paragraph 61, lines 12-14;

Note: the STB can determine whether the channel being tuned needs to be descrambled, which can only be done by the STB);

if the channel was an STB tuned channel, then sending, from the remote control, a signal to the media center set-top box to indicate that the television is on line with the STB tuned channel (paragraph 59, lines 18-23; paragraph 60, lines 14-20; paragraph 61, lines 12-14 and 18-21);

if a tuner in the media center set-top box is not available for the television (paragraph 61, lines 18-21), then receiving at the remote control, from the media center set-top box, an indication identifying a cable channel that was most recently STB turned channel for the television (paragraph 60, lines 14-20; paragraph 61, lines 18-21); and

automatically changing the television with the remote control to the identified cable channel to satisfy expectations of a user when the tuner is not available for the television (paragraph 61, lines 18-21).

Ellis does not disclose a method for determining a last channel to which a television was tuned prior to the television being turned off;

determining whether the last channel tuned to prior to being turned off was a radio frequency remodulated (RF-remodulated) channel via a media center set-top box.

In an analogous art, Arad teaches a method for determining whether the last channel tuned to was a radio frequency remodulated (RF-remodulated) channel via a media center set-top box (paragraph 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the remodulating taught by Arad to the method disclosed by Ellis. The motivation would have been to allow the VCR to record scrambled shows such as HBO by having the STB tune to them and then modulate them onto a channel the VCR can tune to (Ellis: paragraph 59, lines 18-23; page 4, paragraph 41, lines 4-7).

Ellis and Arad do not disclose a method for determining a last channel to which a television was tuned prior to the television being turned off.

In an analogous art, Silver teaches a method for determining a last channel to which a television was tuned prior to the television being turned off (column 4, lines 29-35).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the last channel recall taught by Silver to the method disclosed by Ellis and Arad. The motivation would have been to enable the user to not need to search for the previous channel they were watching, thereby eliminating delay experienced by the user.

Claims 7, 13, and 16 are rejected on the same grounds as claim 4.

Claims 5, 6, 8, 9, 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis, Arad and Silver as applied to the claims above, and further in view of Bates.

Referring to claim 5, Ellis discloses a method of claim 1, further comprising: receiving a channel change command using a programming guide (paragraph 61, lines 18-21).

Ellis, Arad and Silver do not disclose a method wherein the channel change command is a channel up signal; and changing the television to an adjacent cable channel one above the cable channel.

In an analogous art, Bates teaches a method wherein the channel change command is a channel up signal; and changing the television to an adjacent cable channel one above the cable channel (column 6, lines 18-28).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to substitute the EPG channel change with the channel up/down command taught by Bates as the combination would have yielded predictable results.

Claims 8, 14, and 17 are rejected on the same grounds as claim 5.



Referring to claim 6, Ellis discloses a method of claim 1, further comprising: receiving a channel change command using a programming guide (paragraph 61, lines 18-21).

Ellis, Arad and Silver do not disclose a method wherein the channel change command is a channel down signal; and changing the television to an adjacent cable channel one below the cable channel.

In an analogous art, Bates teaches a method wherein the channel change command is a channel down signal; and changing the television to an adjacent cable channel one below the cable channel (column 6, lines 18-28).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to substitute the EPG channel change with the channel up/down command taught by Bates as the combination would have yielded predictable results.

Claims 9, 15 and 18 are rejected on the same grounds as claim 6.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/  
Supervisory Patent Examiner, Art  
Unit 2424

JS

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